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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,789

03/29/2004

Grant James Ryan

12000057-0002

4225

26263

7590

04/13/2009

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EXAMINER

ENG, DAVID Y

ART UNIT

PAPER NUMBER

2455

MAIL DATE

DELIVERY MODE

04/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/812,789	Applicant(s) RYAN ET AL.	
	Examiner DAVID Y. ENG	Art Unit 2455	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 31-32, 54, 55, 57, 69, 63, 56, 58-60, 62, 64-68, 35, 36-37, 40, 38-39, 46, 47, 89, 97, 30, 34, 43, 45, 48-50, 91-92, 93, 98, 99, 100-103, 105, 80, 81-82, 83-88, 104, 106, 107, 111-112, 108-110, 113, 114-116, 117-118, 119 and 120 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 9-13, 15, 21, 23, 27-29, 95 and 96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-5, 7, 9-13, 15, 21, 23, 27-41, 43, 45-50, 54-60, 62-70, 80-89, 91-93 and 95-120

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1, 2, 3, 4-5, 9, 10, 11-13, 7, 15, 95-96, 21, 23, 27, 28 and 29 drawn to a social system having a host computer, a database and a plurality of input devices all connected to a data network, for providing context information, classified in class 709, subclass 219.
- II. Claims 31-32, 54, 55, 57, 69, 63, 56, 58, 59, 60, 62, 64-68, 33, 41, 35, 36-37, 40, 38, 39, 46-47 and 89, drawn to social network configured to allow a user to control the value of Nth degree of connections separating the user from a contact to be included, classified in class 709, subclass 220.
- III. Claims 97, 30, 34, 43, 45, 48-50, 91-93 and 98, drawn to a system for allowing a user to define his degree of participation or role in an application, classified in class 709, subclass 223.
- IV. Claims 99, 70, 100-103, 105, 80-88 and 104, drawn to social network configured to allow user to perform roles, classified in class 709, subclass 220.
- V. Claims 106, 107, 111-112, 108-110 and 113, drawn to method of creating a private personal social network, classified in class 709, subclass 217.

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- VI. Claims 114-116 and 120 drawn to configuring of social network software application, classified in class 709, subclass 220.
- VII. Claims 117-118, drawn to a method of operating a social network system, classified in class 709, subclass 220.
- VIII. Claim 119, drawn to a method of operating a social network system by configuring an application so as to allow a user to be either a provider or a participant, classified in class 709, subclass 220.

The inventions are distinct, each from the other because of the following reasons:

Inventions I to VIII are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the social network (comprising host computer processor, data base and plurality of data input devices) do not require to be configured as specifically claimed in the subcombination. The subcombination has separate utility such as a system which does not required to be configured specifically.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be

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examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Constructive Election (37CFR 1.142b)

Newly amended and submitted claims 1-5, 7, 9-13, 15, 21, 23, 27-41, 43, 45-50, 54-60, 62-70, 80-89, 91-93 and 95-120 are directed to inventions that are independent or distinct from the invention originally claimed for the reasons set forth above.

Since applicant has received an action on the merits for the originally presented invention (1, 2, 3, 4-5, 9, 10, 11-13, 7, 15, 95-96, 21, 23, 27, 28 and 29), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-32, 54, 55, 57, 69, 63, 56, 58-60, 62, 64-68, 35, 36-37, 40, 38-39, 46, 47, 89, 97, 30, 34, 43, 45, 48-50, 91-92, 93, 98, 99, 70, 100-103, 105, 80, 81-82, 83-88, 104, 106, 107, 111-112, 108-110, 113, 114-116, 117-118, 119 and 120 are withdrawn from consideration as being directed to non-elected inventions. See 37 CFR 1.142(b) and MPEP § 821.03.

Status of Claims

Claims 6, 8, 14, 16-20, 22, 24-26, 42, 44, 51-53, 61, 71-79, 90, 94 have been **cancelled**. **Newly submitted claims** 95 -120 have been entered. The **pending claims** are 1-5, 7, 9-13, 15, 21, 23, 27-41, 43, 45-50, 54-60, 62-70, 80-89, 91-93 and 95-120 of which 1, 31, 97, 99, 106, 114, 117, 119, 120 are independent claims. Claims 31-32, 54, 55, 57, 69, 63, 56, 58-60, 62, 64-68, 35, 36-37, 40, 38-39, 46, 47, 89, 97, 30, 34, 43, 45, 48-50, 91-92, 93, 98, 99, 100-103, 105, 80, 81-82, 83-88, 104, 106, 107, 111-112, 108-110, 113, 114-116, 117-118, 119 and 120 **are withdrawn from consideration** as being directed to non-

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elected inventions. **The active claims are** 1, 2, 3, 4, 5, 9, 10, 11, 12, 13, 7, 15, 95, 96, 21, 23, 27, 28 and 29.

Abstract

The present abstract is objected to as being unclear. A new abstract which is more aptly descriptive of the nature and gist of the technical disclosure is requested. The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. It is not clear what the user is allowed to do.

Claim Rejections - 35 USC § 112, 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 3, 4, 5, 9, 10, 11, 12, 13, 7, 15, 95, 96, 21, 23, 27, 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification merely consists of statements stating what the system is expected to do. The specification fails to disclose how to configure a system for

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providing 1. each user entity with a virtual, unique, private, personal, social network formed from connections between contacts, the contacts being entities connected directly or indirectly to a user entity and 2. further providing respective interrelationship context information associated with a connection between at least two contacts and/or between a contact and the user as recited in the last paragraph of independent claim 1. The specification fails to disclose how system is able to achieve the capabilities as expected in the wherein-statements of dependent claims.

Claim Rejections - 35 USC § 112, 2nd paragraph, omitted element

Claims 1-5, 9-13, 7, 15, 95-96, 21, 23, 27, 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

With respect to independent claim 1, the omitted elements are: the components which would render the social network system to provide the functions set forth in the last paragraph of independent claim 1.

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 9-13, 7, 15, 95-96, 21, 23, 27, 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly

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point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, it is not clear what respective interrelationship context information associated with a connection is.

The description of each node in claim 15 is not understood.

In claim 95, there is no functional relationship between the displaying means and the components of the social network recited in parent claim 1.

Applicants are requested to identify the support of all rejected claims in the specification so as to ascertain the scope of limitation of the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 4, 5, 9, 10, 11, 12, 13, 7, 15, 95, 96, 21, 23, 27, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay et al (USP6,430,602) in view of Bastian et al. (USP 6,757,712).

See Figure 1 and the description thereof in Kay. Kay teaches:

Claims 1, 29

A social network system (Figure 1, instant messaging system) comprising:

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at least one host computer processor (provider's server 17) connectable to at least one data network (14);

a database (24) accessible over said data network (14); and

a plurality of data input devices (users, 18) connectable to said data network,

wherein said system is configured (Bastian et al. secondary reference) to provide each user entity with a virtual, unique, private, personal, social network (herein a 'social network') formed from connections between contacts, said contacts being entities connected directly or indirectly to a user entity, said social network further providing respective interrelationship context information associated with a connection between at least two contacts and/or between a contact and said user.

As shown above, Kay et al teaches a social network (instant messaging network). It is not clear whether Kay's network is configured to a social network of virtual, unique, private and personal (VPN). VPN (virtual, private network) is well known in the art. Bastian et al teaches a social network (instant messaging column 6, line 24). The social network is configured to a virtual, unique, private and personal network (VPN, abstract). From the teaching of Bastian et al, it would have been obvious to a person of ordinary skill in the art to configure the social network of Kay to a VPN network so that communication in Kay can be private, virtual, unique and personal.

Claims 2-5, 7, 9-10, 15,

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The claims merely consist of non-functional descriptive material which is not patentably distinct over the applied references. The recitations are descriptive in nature and the limitations have no functional value. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

See claim 2 for example, whether or not the entities includes any individual, family, personal or organized network, organization, club, society, company, partnership, religion, or entity that exists as a particular and discrete unit is descriptive in nature and has no functional effect on the social network or configuration of the network.

Claims 11-13,

Access in VPN is inherently restricted because it is a private network.

Claims 95, 96

An instant messaging system inherently has a display device. It is inherent because without it, it does not work. The display content has no patentable weight because it constitutes non-functional descriptive material. What is displayed on the monitor has no functional value to the social system.

Claims 21,

No patentable weight is given to procedure for joining a social club.

Claim 23,

Definition is not a patentable subject matter.

Claims 27, 28

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No patentable weight is given to the details of interrelationship context information because it has no functional relationship to the components of the social network.

Response

Applicant's arguments with respect to claims 1-5, 7, 9-13, 15, 21, 23, 27-41, 43, 45-50, 54-60, 62-70, 80-89, 91-93 and 95-120 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Y. ENG whose telephone number is 571-272-3984. The examiner can normally be reached on M-F from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SALEH NAJJAR, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID Y. ENG/

Primary Examiner, Art Unit 2455